REMARKS

In view of the following remarks responsive to the Office Action dated January 26, 2006, Applicant respectfully requests favorable reconsideration of this application.

All claims remain rejected as anticipated by Elston.

Based on the telephone interview conducted earlier during the prosecution of this application, it is Applicant understands that the Examiner believes that the present application discloses an invention that is patentable over Elston, but that the claim language does not sufficiently recite such distinctions at this time.

In the latest Office Action, the Examiner asserts that he believes the interpretation of the term "location" is the crux of the present dispute.

Applicant disagrees. Particularly, Applicant does not believe that its arguments depend in any significant respect on the particular interpretation of the term "location".

In defining the term "location", the Examiner refers to paragraph 22 of the present application. However, as pointed out in response to the previous Office Action, paragraph 22 helps define the term "location type", and not the term "location". Applicant does not believe it is using the term “location” in an unusual way.

Nevertheless, Applicant will attempt to address the Examiner's concerns with respect to the terms location" and "location type". In the Response to Arguments section of the Office Action, after quoting paragraph 22, the Examiner noted that:

> In the Examiner's interpretation, the "location" could be a type V, including inventory that is stored off-site for products that are in the process of manufacture wherein one or more stages of the manufacturing process occur at a vendor's off-site location. The location can be a type C where the customer is a retailer. The queries in question are the queries to determine where in the supply chain the assets are.
>
> The Examiner can consider these "locations" to be capitalized fixed assets for the supplier because, as inventory with a cost per unit value, it should be capitalized. Applicant has argued this from the purchaser's point of view.

From the first paragraph quoted above, it appears that the Examiner is justifying that the goods at issue in Elston could be either type V or C goods and that Elston determines whether they are type V or C goods.

There is nothing in Elston to suggest that the goods discussed are anything other than goods ready for sale that are physically located at a particular site, i.e., location. Furthermore, it is unclear that it would matter to patentability of the claims even if the Examiner was correct. The only way that it could even be relevant to the patentability of the claims is if Elston's software determined whether a good was a V or C type good, which it does not. Elston's system does not figure out whether it is a type V or C good, just which retailers have the good and which one is most suitable for filling the order. This has nothing to do with determining the location of the good.

With respect to the second paragraph quoted above, the Examiner asserts that locations can be capitalized fixed assets. Applicant does not understand. Applicant doubts that the Examiner means to refer to the real estate of the particular retailer since nothing else in the Office Action suggests this is the Examiner's interpretation. On the other hand, it is not understood how a "location" (or even a "location type") could be considered a capital fixed asset.

If the Examiner meant to assert that one of Elston's goods (1) could be at a physical location, (2) could be a good of a certain location type, and/or (3) could be a capital fixed asset, Applicant certainly cannot dispute this. Applicant concedes that any good could be a capital fixed asset and could have a location type and/or a location. Rather, Applicant disputes that Elston's system determines location (or location type) at all, let alone in the manner claimed in the present application.

Applicant stands by its positions set forth in response to the previous Office Action.

In addition, Applicant offers the following additional explanations.

Step (2) of claim 1 recites "running said asset through a plurality of queries, each query designed to determine if said asset meets a set of criteria indicative of the

category of how a location of said asset for tax and/or insurance reporting purposes may be determined". The Examiner asserts that paragraphs 259-265 of Elston show the data of the product going through a series of information queries to determine if the product meets the criteria indicative of availability status.

Applicant respectfully traverses. Step (2) must be read in conjunction with step (3), which recites that "if, in step (2), said asset meets said set of criteria corresponding to one of said queries, running data corresponding to said asset through an audit customized to said corresponding category...". Thus, in conjunction, steps (2) and (3) make it clear that the "plurality of queries" comprises separate and distinct queries, each comprising a set of criteria that is used to determine whether the asset corresponds to the subject matter of that particular query. Claim 3 refines this aspect of claim 1 by reciting that the asset is run through the plurality of queries hierarchically, wherein, when the asset meets a set of criteria of a particular query, the asset is not run through any queries ordered lower in the hierarchy.

This is nothing like what is disclosed in paragraphs 259-265 of Elston. This section of Elston deals with determining which store to select for providing a requested good to the particular customer. See paragraph 254 of Elston. Paragraphs 259-265 list a "variety of data sources to compute the optimum scheduling of orders or computation of wait time for each store". It lists six such "data sources", including, for instance, (1) information from the merchant's inventory system, (2) information from the merchant's reservation management system, and (3) information on predicted capacity, staff availability and other variables input to the order terminal by a store manager. By using the phrase "variety of data sources", it seems clear that Elston contemplates using only one of those data sources to determine which store to select to fill the order and is simply listing a bunch of options for the data source. Perhaps the Examiner is reading paragraphs 259-265 as discussing an algorithm that combines information from these six data sources to make the determination. Such an interpretation would not be reasonable. Furthermore and more importantly, it would not make one bit of a

difference to the claim analysis it if did, since the claims would not read on it in any event.

Specifically, neither interpretation constitutes running through the data sources individually and selecting one of the data sources based on the information in that data source for the good.

With respect to Claim 3, the Examiner asserted that the six queries in paragraphs 259-265 of Elston are in reverse hierarchical order, for example, if the product matches the inventory in stock (number 6) there is no need to continue the reservation system, the predicted capacity system, and so on".

The Examiner's position with respect to claims 1 and 3 demonstrates what Applicant believes to be the basic misunderstanding between Applicant and the Examiner. The Examiner's position that Elston teaches a plurality of queries and/or that Elston runs through the queries hierarchically is without basis. Particularly, with respect to the six data sources listed in paragraphs 260-265, paragraph 259 states that the "order delivery system 40 can use a variety of data sources to compute the optimum scheduling of orders". This language seems to demand that the six listed data sources are potential alternate sources of such information. On the other hand, the Examiner may believe that paragraph 259 recites combining data from the six data sources into an algorithm (an interpretation which Applicant does not believe is justified). However, it is not seen how a person of skill in the art reading these paragraphs could possibly understand it to suggest running through the data sources separately and individually, let alone hierarchically, and most puzzlingly, in the reverse order in which they are listed.

Accordingly, claim Elston does not anticipate 1 because it does not meet at least steps (1) and (2) thereof, even if it determines both the physical location of and taxes on the selected good.

However, while the above arguments address important aspects of the patentability of the present invention over Elston, we have not yet even touched on a

much more fundamental patentable distinction of the present invention over Elston. Particularly, Elston does not have anything to do with determining the location of an asset, which is the basic premise of the present invention.

The Examiner is relying on the Order Queue Management system that is discussed in paragraphs 254-266 of Elston in his rejections. This system merely determines a particular store that will service the order for the good.

In Elston, the goods are fungible and there are many copies of each good available at many different sites. Elston's Order Queue Management system is attempting to determine which particular copy of a good to deliver to the customer. Let us assume that the good that has been ordered is a compact disc (CD) of a Dizzy Gillespie recording. Elston's database already knows, for instance, that site A has 20 copies of that CD, site B is out of stock of that CD, and site C has 15 copies of that CD. Elston's system is merely trying to figure out what is the best site to assign to provide that CD to the customer. Thus, by definition, Elston already knows where all the copies of that CD in its overall inventory are located and, in this sense, has, in fact, determined the location(s) of the good (but the Examiner does not appear to be relying on any portion of Elston pertaining to this topic, nor should he, since this probably comprises simply looking it up in a database). The whole premise of Elston's Order Queue Management system (OQM) is that it already knows the location(s) of the goods. If Elston did not already know where the various copies of that CD were, nothing else in Elston would make any sense. The OQM is merely determining which one of the copies of the CD to sell to the customer. The present invention, on the other hand, is attempting to determine the tax/insurance location of an asset.

Thus, even ignoring for the moment the distinction between determining the tax/insurance location of an asset as opposed to its physical location, the present invention, is patentably distinct over Elston.

Determining the location of a good is a very different proposition than determining which copy of that good should be selected for a pending sale. (Of course,

Elston actually does not decide the exact single copy, but merely, for instance, that it will be one of the 20 copies located at site A).

Referring to the specific claim language that patentably distinguishes over Elston, claim 1 recites "running data for said asset through a plurality of queries, each query designed to determine if said asset meets a set of criteria indicative of the category of how a location of said asset for tax and/or insurance reporting purposes may be determined" (step 2), "running data corresponding to said asset through an audit customized to said corresponding category to determine a location of said asset for tax and/or insurance reporting purposes" (step 3) and "assigning said determined location to said asset for tax and/or insurance reporting purposes" (step 4). It is not seen how the act of determining a location from which a good will be delivered to a customer could possibly meet any of these limitations.

Accordingly, claim 1 clearly distinguishes over Elston.

The dependent claims 2- 7 are patentable over Elston for at least all the reasons as set forth in connection with claim 1 in this response and previous responses. In addition, the dependent claims add even further distinguishing features as previously discussed in the response to the previous Office Action and which will not be repeated herein.

Independent claim 8 is similar to claim 1 and distinguishes over Elston for at least all of the same reasons set forth above in connection with claim 1.

Dependent claims 9-18 are patentable for at least all the same reasons as claim 8 and for all the additional reasons set forth in response to the previous Office Actions. Claim 19 and dependent claims 20 and 21 generally correspond in substance to claims 1, 2, and 3 and distinguish over Elston for at least all of the same reasons discussed above and in the previous responses as claims 1, 2, and 3, respectively.

In view of the foregoing amendments and remarks, Applicant asserts that the pending claims are in condition for allowance and respectfully request that the Office issue a Notice of Allowance at the earliest possible date. The Office is invited to contact Applicant's undersigned counsel by telephone call in order to further the prosecution of this case in any way.

Respectfully submitted,

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